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|---|-------------|----------------------|------------------------------|------------------|
| 10/728,879  | 12/08/2003  | Eugene M. Lee        | 113708.127US2                | 9649             |
| 23400   | 7590        | 05/31/2007           |                              |                  |
| POSZ LAW GROUP, PLC<br>12040 SOUTH LAKES DRIVE<br>SUITE 101<br>RESTON, VA 20191 |             |                      | EXAMINER<br>DARNO, PATRICK A |                  |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/728,879 | <b>Applicant(s)</b><br>LEE, EUGENE M. |  |
|                              | <b>Examiner</b><br>Patrick A. Darno  | <b>Art Unit</b><br>2163               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 March 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 14-23 and 26-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-23 and 26-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-13 and 24-25 are cancelled. Claims 14, 16-20, 23, 26, and 28-30 have been amended. Claims 14-23 and 26-31 are pending in this office action.

#### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 14-16, 18-20, 23, 26, and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application Publication Number 2004/0024739 issued to Max Copperman et al. (hereinafter “Copperman”).

#### **Claim 14:**

Copperman discloses a method of utilizing an intellectual property thesaurus to search a collection of intellectual property documents (*Copperman: paragraph [0059] – paragraph [0061] and paragraph [0162]*), the method comprising:

(a) designating a field of search including selection of at least one of a plurality of classifications of an intellectual property classification system, wherein the field of search includes plural intellectual property documents (*Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; In the first reference cited ([0059] – [0061]), Copperman clearly discloses a system which stores intellectual property documents which are classified by use of a taxonomy. Surely a system, which stores classified intellectual property, is an ‘intellectual property classification system’. The second reference cited*

*clearly discloses the user selecting specific classifications (taxonomies and concept nodes) of documents. Each taxonomy contains a plurality of documents. And, as noted above, the documents may be intellectual property.);*

(b) generating a list of words found in the content of the plural intellectual property documents classified in the field of search designated in said designating step (a) (*Copperman: paragraph [0008], lines 9-12 and paragraph [0075] and paragraph [0141], lines 1-5*);

(c) entering search criteria utilizing keywords that formulate a search query, wherein the keywords can be different from the words in the list of words (*Copperman: paragraph [0154], lines 1-8; Note the user first a natural language query in addition to selecting specific classifications or taxonomies. The natural language query may contain keywords different from the words on the generated list.*);

(d) determining searchable elements related to select keywords in the search criteria of step (c) by locating words in the list of words generated in said generating step (b) that are synonyms of the select keywords (*Copperman: paragraph [0154], lines 1-9 and paragraph [0162] and paragraph [0178]*); and

(e) executing, in a computer, the search query to search the content of the intellectual property documents using the select keywords and the synonyms of the select keywords, and receiving results returned from executing the search query (*Copperman: paragraph [0155] and paragraph [0156], lines 3-5*).

**Claim 15:**

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said generating step (b) further comprises the step of determining a frequency of occurrence of each listed word found in the intellectual property information

associated with the field of search (*Copperman: paragraph [0082], lines 8-16 and paragraph [0122], lines 39-45*).

**Claim 16:**

Copperman discloses all the elements of claim 15, as noted above, and Copperman further discloses:

displaying, in the form of a word-frequency list, the list of words found in the intellectual property information classified in the field of search, wherein each listed word is associated with a corresponding frequency of occurrence of the listed word (*Copperman: paragraph [0122], lines 39-45 and paragraph [0122], lines 55-57; Note specifically that the terms (for which word frequencies were determined) are presented (displayed) to a user.*).

**Claim 18:**

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said determining step (d) further comprises:

storing the synonyms thus determined in an accrued synonym list corresponding to the select keyword in the search query (*Copperman: paragraph [0162]; Since there is a thesaurus and/or a list of synonyms, these words in the thesaurus and/or list of synonyms must have been stored.*).

**Claim 19:**

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said determining step (d) is automatically preformed to determine synonyms for keywords in the search query (*Copperman: paragraph [0162], lines 1-6; Note specifically that the search query is actually 'performed'.*).

**Claim 20:**

Copperman discloses all the elements of claim 14, as noted above, and Copperman further discloses wherein said step (c) further comprises the step of automatically incorporating into the search criteria synonyms from the accrued synonym list (*Copperman: paragraph [0162], lines 1-6*).

**Claim 23:**

Copperman discloses in a search system for use in searching for intellectual property documents (*Copperman: paragraph [0059] – paragraph [0061] and paragraph [0162]*), the improvement comprising an article of manufacture having stored thereon an executable program operative to effectuate searching for intellectual property documents in connection with the search system, wherein the executable program is executed to perform the steps of:

(a) designating a source grouping comprising plural intellectual property documents (*Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; See rejection of claim 14 for further comments on these references.*);

(b) generating a list of words found in the content of the plural intellectual property documents within the source grouping designated in said designating step (a) (*Copperman: paragraph [0008], lines 9-12 and paragraph [0075] and paragraph [0141], lines 1-5*);

(c) entering search criteria utilizing keywords that formulate a search query, wherein the keywords can be different from the words in the list or words (*Copperman: paragraph [0154], lines 1-8; Note the user first a natural language query in addition to selecting specific classifications or taxonomies. The natural language query may contain keywords different from the words on the generated list.*);

(d) determining searchable elements related to select keywords in the search criteria of step (a) by locating words in the list of words generated in step (b) that are synonyms of the select keywords (*Copperman: paragraph [0154], lines 1-9 and paragraph [0162] and paragraph [0178]*); and

(e).executing the search query using to search the content of the plural documents using the select keywords and the synonyms of the select keywords, and receiving results returned from executing the search query (*Copperman: paragraph [0155] and paragraph [0156], lines 3-5*).

**Claim 26:**

Copperman discloses all the elements of claim 23, as noted above, and Copperman further discloses wherein said designating step (a) further comprises:

receiving input signals from a user containing a selection of at least one of a plurality of classifications of an intellectual property classification system; and designating the source grouping as a field of search based on the input selection from the user (*Copperman: paragraph [0059] – paragraph [0061] and paragraph [0154], lines 1-8; In the first reference cited ([0059] – [0061]), Copperman clearly discloses a system which stores intellectual property documents which are classified by use of a taxonomy. Surely a system, which stores classified intellectual property, is an ‘intellectual property classification system’. The second reference cited clearly discloses the user selecting specific classifications (taxonomies and concept nodes) of documents. As noted above, the documents can include intellectual property documents.*).

**Claim 28:**

Copperman discloses all the elements of claim 23, as noted above, and Copperman further discloses wherein the source grouping includes selected plural intellectual property documents stored in a database (*Copperman: paragraph [0059] – [0061]*), and wherein said generating step (b) includes the step of retrieving the selected intellectual property documents from the

database and compiling the list of words found in the retrieved intellectual property information  
(*Copperman: paragraph [0008], lines 9-12 and paragraph [0075]*).

**Claim 29:**

Claim 29 is rejected under the same reasons set forth in the rejection of claim 20.

**Claim 30:**

Copperman discloses all the elements of claim 29, as noted above, and Copperman further discloses wherein the executable program further comprises the step of:

outputting the search criteria to a user interface (*Copperman: paragraph [0156], lines 3-5; Note specifically that the search engine 'returns documents' to a user.*); and

accessing at least one remote database unit for intellectual property documents corresponding to the search criteria (*Copperman: paragraph [0037] and paragraph [0042] and paragraph [0059] – [0061] and paragraph [0162], lines 1-6; The first two references clearly show that the search queries are intended to be executed remotely over a network in specifying that the invention is an 'e-service portal' and further specifying that the invention can be implemented in a client-server arrangement.*).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 17, 21-22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman and further in view of U.S. Patent Application Publication Number 2004/0230574 issued to Alexander N. Kravets (hereinafter "Kravets").



**Claim 17:**

Copperman discloses all the elements of claim 16, as noted above, and Copperman further discloses the display of the word-frequency list (*Copperman: paragraph [0122], lines 39-45 and paragraph [0122], lines 55-57*).

Copperman does not explicitly disclose wherein said displaying step comprises simultaneous display of the search criteria during operation of said entering step. However, Kravets discloses wherein said displaying step comprises simultaneous display of the search criteria during operation of said entering step and the display of the word-frequency list (*Kravets: paragraph [0044], lines 1-15 and Fig. 6, 300 and Fig. 8, 320*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Copperman with the teachings of Kravets noted above for the purpose of displaying both the user's input query and suggested search terms based upon a word-frequency list simultaneously (*Kravets: [0044]*). The skilled artisan would have been motivated to improve the teachings of Copperman per the above such that predicted or suggested search terms are presented to the user in order to aid the user in locating the best search results (*Kravets: paragraph [0044], lines 9-15*).

**Claim 21:**

The combination of Copperman and Kravets discloses all the elements of claim 17, as noted above, and Copperman further discloses wherein utilizing an intellectual property thesaurus further comprises:

(f) submitting the search criteria as a search query to the database (*Copperman: paragraph [0162], lines 1-6; When the search query is 'performed', the search query is submitted to a database.*).

**Claim 22:**

The combination of Copperman and Kravets discloses all the elements of claim 21, as noted above, and Copperman further discloses wherein said submitting step (f) includes transmission of the search query to a remote database over the Internet (*Copperman: paragraph [0037] and paragraph [0042] and paragraph [0162], lines 1-6; The first two references clearly show that the search queries are intended to be executed remotely over a network in specifying that the invention is an 'e-service portal' and further specifying that the invention can be implemented in a client-server arrangement.*).

**Claim 31:**

Claim 31 is rejected under the same reasons set forth in the rejection of claim 17.

4. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Copperman and further in view of U.S. Patent Number 5,991,751 issued Kevin G. Rivette et al. (hereinafter "Rivette").

**Claim 27:**

Copperman discloses all the elements of claim 26, as noted above, but Copperman does not explicitly disclose wherein the classification system is the system used by the U.S. Patent and Trademark Office for classification of patents, and wherein the input signals contain a selection of a plurality of classes and subclasses that form the source grouping.

However, Rivette discloses wherein the classification system is the system used by the U.S. Patent and Trademark Office for the classification of patents (*Rivette: column 17, lines 55-66*), and wherein the input signals contain a selection of a plurality of classes and subclasses that form the source grouping (*Rivette: Fig. 57, 5718-5722*).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the teachings of Copperman with the teachings of Rivette noted above. The skilled artisan would have been motivated to improve the teachings of Copperman per the above such that a user could easily identify patents that satisfy a specified key word search criteria

(Rivette: column 2, lines 25-26).

### ***Response to Arguments***

#### **Applicant Argues:**

Copperman fails to teach or suggest, for example, "generating a list of words found in the content of the plural intellectual property documents." (See, e.g., claims 14, 23) To the contrary, Copperman is concerned with properly categorizing each document by its own contents, so that each document can be converted. Thus Copperman does not and cannot use the list of words from plural documents that are in the classification.

The office action cites paragraphs [0008] and [0075] as being particularly relevant, where paragraph [0075] discusses the detail of spotting technical terms in the content of a particular document, with reference to Fig. 5 illustrating the conversion of a document into Copperman's standard format. Each converted document is inserted with taxonomy tags appropriate to the document's content, and can indicate "exactly the portion of the knowledge container that is most relevant to their question." (E.g., paragraph [0082]-[0083].)

Copperman, however, fails to teach or suggest generating a list of words found in the content of plural documents in the designated field of search. To the contrary, Copperman aims to mark each individual document with its own taxonomy based on its own content. It follows that Copperman fails to teach or suggest generating a list of words located in the content of multiple documents.

#### **Examiner Responds:**

Examiner is not persuaded. It appears that the Applicant's argument hinges on the fact that the Applicant's interpretation of the Copperman reference is such that the Copperman reference only generates a list of words for a single document as opposed to generating a list of words from multiple documents. The Examiner respectfully disagrees with this interpretation.

First, the Examiner notes that if one can generate a list of words from a single document, one can surely generate a list of words from multiple documents. However, this viewpoint alone does not refute the Applicant's argument.

The Examiner asserts that there is support in the Copperman reference for generating a list of words from a plurality of documents. This support is found on at least one occasion at paragraph [0141], lines 1-5. The Copperman reference clearly recites:

Next, in step 940, a report is generated for all clusters produced in Step 938. The total number of clusters is the sum of the clusters generated for each of the taxonomies. **For each cluster, the report lists the most significant terms in order of importance.** This term list is the basis for cluster naming in Step 944, below. (emphasis added)

Based on the above passage, it is clear that the Copperman reference, at the very least, suggests generating a list of words from a plurality of documents (i.e., one list is generated for each cluster). Furthermore, it is clear from numerous passages in the Copperman reference that these extracted terms, used to generate list of words describing particular taxonomies, clusters, or classifications of plural documents, can be used to further augment a query in order to modify a query's search scope (see at least Copperman: paragraph [0162] and [0178]).

Therefore, since it appears that the Copperman reference discloses or suggests each and every element of the Applicant's claimed invention, the rejections given under 35 U.S.C. 102(e) are upheld.

**Applicant Argues:**

Copperman fails to teach or suggest, as another example, "determining searchable elements...by locating words in the list of words...that are synonyms of the select keywords." (E.g., claims 14, 23.) The office action contends that the augmentation or expansion of a query discussed in Copperman, paragraph [0162], lines 1-6 teaches this. Paragraph [0162] states that "query expansion may be based upon a thesaurus, to include synonyms or other related terms in the text." This is the only mention of a thesaurus

in Copperman. Copperman, paragraph [0162] discusses autocontextualization including topic taxonomy tab identification. However, Copperman's taxonomy tags are in Copperman's converted document (e.g., Fig. 5), not in the "list of words" found in the plural intellectual property documents. Copperman simply fails to teach or suggest the combining of locating words in the list of words which are synonyms of the keywords selected for the search criteria, and using those synonyms as search criteria, where the synonyms are located in the list of words which is "found in the content of the plural...documents."

**Examiner Responds:**

Examiner is not persuaded. The Copperman reference clearly generates a list of words from the content of plural documents (Copperman: paragraph [0008], lines 9-12 and paragraph [0075] and paragraph [0141], lines 1-5). Furthermore, it is shown in the above office action that the documents stored in the Copperman reference can be intellectual property documents. Finally, the Examiner has pointed out at numerous locations of the preceding office action that the Copperman reference uses words from the generated list as query terms and words which are synonyms or related to the already included query terms (see at least Copperman: paragraph [0162] and [0178]). In paragraph [0162], Copperman even explicitly mentions using a thesaurus to help augment the query.

Therefore, since it appears that the Copperman reference discloses or suggests each and every element of the Applicant's claimed invention, the rejections given under 35 U.S.C. 102(e) are upheld.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

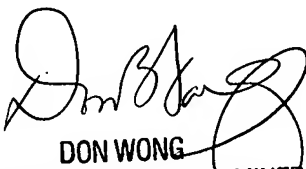
***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick A. Darno whose telephone number is (571) 272-0788. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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